

Application No. 09/749,255
Reply to Office Action of November 3, 2004

REMARKS

Presently, claims 2-5, 10-12 and 28-40 are pending in the application. The specification has been amended to correct formal errors noted by Applicants. Claims 1, 6-9 and 13-27 have been canceled. New claims 28-40 have been added to more particularly point out the present invention. Support for the features of new claims 28-33 may be found, for example, in original claim 1 and at page 10, line 28-page 11, line 7; page 12, line 22 – page 13, line 11; and page 15, lines 1-30 of the specification. Support for the features of new dependent claims 32-40 may be found, for example, in original claims 2-5 and 10-12, respectively. Claims 2-5 and 10-12 have been amended to depend from and be consistent with new independent claim 28. Accordingly, no new matter has been added by the foregoing amendments.

Specification

The specification has been amended as shown above to correct formal errors noted by Applicants. No new matter has been added to the application by the amendments to the specification. Entry of the amendments to the specification are respectfully corrected.

Prior Art Rejection – § 102(e)

The Examiner has rejected claims 1, 7, 9, 10, 12, 19, 21 and 23-25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,177,931 to Alexander *et al.* (“Alexander”). The Examiner contends that Alexander discloses each and every element of the present invention.

Although not necessarily agreeing with the Examiner, claims 1, 7, 9, 19, 21 and 23-25 have been canceled. Dependent claims 10 and 12 have been amended to depend from new independent claim 28. Accordingly, the Examiner’s §102(e) rejection over Alexander is moot. However, to the extent that this rejection is applied to any of the presently pending claims, Applicant respectfully traverses this rejection.

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Alexander teaches improvements to electronic program guides ("EPGs"), including viewer interaction capabilities, opportunities for advertisers to reach viewers and creating of viewer profiles. Alexander's system allows the viewer to interact with the EPG, including selecting programming (including advertisements) for viewing and/or recording. The user may also interact with the EPG by scrolling through the listings which are not displayed on the initial screen. The EPG in Alexander collects information about the viewer, either by obtaining the requested information directly from viewer input or learning the desired information by recording the viewer's "actions and circumstances surrounding those actions" with the EPG (see column 28, lines 30-59 of Alexander). The information that the EPG records includes instructions provided to the EPG (e.g., a channel change) as well as the time that that change was instructed and the programming switched to and from as a result of the change. The EPG also records the absence of user interaction. Alexander teaches that a "viewer profile analysis program" performs an analysis of the collected data and, combined with the viewer's profile information, develops "viewer characteristics". Alexander then uses the viewer characteristics to customize the EPG, so that the viewer is presented with programming and/or advertisements that are likely to be of interest, both in terms of content and order of display. Alexander also teaches that the EPG may display advertisements based on specific programming that the viewer is watching immediately prior to entering the EPG (see column 26, line 61 – column 27, line 2 of Alexander). Alexander also discloses that certain advertisements may be assigned to particular "classes" of programming.

New independent claim 28 recites:

A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

- (a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;
- (b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads;
- (c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;

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(d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad, wherein the IPG ads are displayed in accordance with the IPG ad queue; and

(e) reordering the IPG ad queue in accordance with the displayed programming ad.

Alexander does not disclose a system or method that incorporates an IPG ad queue that is reordered "in accordance with the displayed programming ad," as recited in independent claim 28. Alexander discloses that an ad may be assigned a priority within a rotation of ads, such that the highest priority ad is displayed each time the same section of the EPG is displayed or entered (see column 26, lines 45-56 of Alexander). Thus, in Alexander, such a prioritized list is not associated with the entire IPG, but rather is associated with only a specific page or section of the EPG. As such, Alexander's prioritized list cannot be considered an "IPG ad queue" as in the present invention. Moreover, Alexander does not disclose that any list of ads (prioritized or not) stored in the EPG is reordered based on the displayed programming ad. In Alexander, the ad that is displayed in the EPG is based on the advertisement that the viewer was watching just prior to entering the EPG. The EPG ad corresponds to the television ad. However, Alexander does not disclose that the EPG performs any other function with respect to the ads in the EPG or the order thereof. The fact that Alexander teaches that "ads can be assigned a priority..." and be displayed in successive rotation according to that priority, does not mean that Alexander discloses an IPG ad queue that is reordered in accordance with the displayed programming ad. Rather, the ads in Alexander are not reordered – in fact, they are kept in the same order – but are simply rotated within that order. Furthermore, the ads are rotated only as a result of a viewer previously visiting that particular section or page of the EPG – not based on the programming ad, as recited in claim 28. Thus, Alexander does not disclose every step recited in independent claim 28. Accordingly, new independent claim 28 is believed to be allowable over Alexander.

Similarly, new independent claim 31 recites, "storing an IPG ad queue; storing a programming ad queue; ...and reordering the IPG ad queue in accordance with a reordering of the programming ad queue." For the same reasons discussed above with

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respect to independent claim 28, Alexander does not disclose all of the steps recited in independent claim 31, in that Alexander does not disclose any reordering of a programming ad queue nor a reordering of IPG ads based on reordering such a programming ad queue. Accordingly, new independent claim 31 is believed to be allowable over Alexander.

Dependent claims 2-5, 10-12, 29-30 and 32-40 are allowable at least by their dependency on new independent claims 28 and 31, respectively. Reconsideration and withdrawal of the Examiner's § 102(c) rejection of claims 1, 7, 9, 10, 12, 19, 21 and 23-25 are respectfully requested.

Prior Art Rejections – § 103(a)

The Examiner has rejected claims 2-3 and 5-6 under 35 U.S.C. §103(a) as being unpatentable over Alexander in view of U.S. Patent No. 6,738,978 to Hendricks et al. ("Hendricks"). For the same reasons discussed above with respect to the Examiner's section 102(e) rejection, Alexander, does not disclose all of the elements recited in independent claims 28 and 31. Thus, claims 28 and 31 are believed to be allowable over Alexander. Applicant respectfully submits that Hendricks does not teach or suggest any of the elements missing from Alexander. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Hendricks. Dependent claims 2-3 and 5 are allowable at least by their dependency on independent claim 28. Claim 6 has been canceled. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 2-3 and 5-6 are respectfully requested.

The Examiner has rejected claim 4 as being unpatentable over Alexander in view of Hendricks and further in view of U. S Patent No. 5,283,639 to Esch ("Esch"). As discussed above with respect to the Examiner's obviousness rejection of claims 2-3 and 5-6, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Hendricks. Applicant respectfully submits that Esch does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Hendricks and

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Esch. Claim 4 has been canceled. Reconsideration and withdrawal of the Examiner's rejection of claim 4 are respectfully requested.

The Examiner has rejected claims 7-8 as being unpatentable over Alexander in view of U.S. Patent No. 6,002,393 to Hite et al. ("Hite"). As discussed above with respect to the Examiner's section 102(e) rejection, Alexander does not disclose all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Hite does not teach or suggest any of the elements missing from Alexander. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Hite. Claims 7-8 have been canceled. Reconsideration and withdrawal of the Examiner's rejection of claims 7-8 are respectfully requested.

The Examiner has rejected claim 11 as being unpatentable over Alexander in view of U.S. Patent No. 6,799,326 to Boylan III et al. ("Boylan"). As discussed above with respect to the Examiner's section 102(e) rejection, Alexander does not disclose all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Boylan does not teach or suggest any of the elements missing from Alexander. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Boylan. Claim 11 is allowable at least by its dependency on independent claim 28. Reconsideration and withdrawal of the Examiner's rejection of claim 11 are respectfully requested.

The Examiner has rejected claims 13-14 and 18 as being unpatentable over U.S. Patent No. 6,029,045 to Picco et al. ("Picco") in view of Alexander. Picco does not teach or suggest a method or system that includes both an IGD ad queue and a programming ad queue, where the IGD ad queue is reordered in accordance with the displayed programming ad, nor a system where the IGD ad queue is reordered in accordance with a reordering of the programming ad queue. Furthermore, as discussed above with respect to the Examiner's section 102(e) rejection, Alexander does not disclose all of the elements recited in independent claims 28 and 31. Since neither Picco nor Alexander do not teach or suggest all of the elements of independent claims 28 and 31 when taken either alone or in combination, independent claims 28 and 31 are believed to be allowable over the combination of Picco and Alexander. Claims 13-14 and 18 have been canceled.

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Reconsideration and withdrawal of the Examiner's rejection of claims 13-14 and 18 are respectfully requested.

The Examiner has rejected claim 15 as being unpatentable over Picco in view of Alexander and further in view of Hendricks. As discussed above with respect to the Examiner's obviousness rejection of claims 13-14 and 18, the combination of Picco and Alexander does not teach or suggest all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Hendricks does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Picco, Alexander and Hendricks. Claim 15 has been canceled. Reconsideration and withdrawal of the Examiner's rejection of claim 15 are respectfully requested.

The Examiner has rejected claim 16 as being unpatentable over Picco in view of Alexander and further in view of U.S. Patent Publication No. 2003/0200128 A1 to Doherty ("Doherty"). As discussed above with respect to the Examiner's obviousness rejection of claims 13-14 and 18, the combination of Picco and Alexander does not teach or suggest all of the elements recited in independent claims 28 and 31.

Doherty teaches a method of scheduling "items of information" (including advertisements) intended for display to localized audiences (e.g., in public transport or waiting areas). In Doherty, each item is assigned a priority according to when it would be most useful to be displayed; the items are then scheduled for display based on their priority. The most suitable ads are determined by calculating priority as a function of time under the "current conditions", such as location, user profile, time remaining for display, etc. Doherty includes a user activity analyzer that monitors user interaction and develops a user profile to assist the scheduler. The priority determination is made "on the run" to react to unpredictable user interaction. The current schedule of items is cleared, for example, when user interaction is detected or other triggering events (such as the beginning of the display period) occur.

Although Doherty teaches the concept of changing a schedule of items based on user interaction, Doherty does not teach or suggest both an IGD ad queue and a programming ad queue, where the IPG ad queue is reordered in accordance with the displayed programming ad, nor a system where the IPG ad queue is reordered in

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accordance with a reordering of the programming ad queue. In Doherty, any "reordering" or "clearing" of the schedule of items depends on the user interaction (or other similar event) and not on the content of a programming ad. Accordingly, Applicant respectfully submits that Doherty does not teach or suggest any of the elements missing from the combination of Picco and Alexander. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Picco, Alexander and Doherty. Claim 16 has been canceled. Reconsideration and withdrawal of the Examiner's rejection of claim 16 are respectfully requested.

The Examiner has rejected claim 17 as being unpatentable over Picco in view of Alexander and further in view of U.S. Patent No. 5,892,535 to Allen et al. ("Allen"). As discussed above with respect to the Examiner's obviousness rejection of claims 13-14 and 18, the combination of Picco and Alexander does not teach or suggest all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Allen does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Picco, Alexander and Allen. Claim 17 has been canceled. Reconsideration and withdrawal of the Examiner's rejection of claim 17 are respectfully requested.

The Examiner has rejected claims 20 and 26 as being unpatentable over Alexander in view of Picco. As discussed above with respect to the Examiner's section 102(e) rejection, Alexander does not disclose all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Pico does not teach or suggest any of the elements missing from Alexander. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander and Picco. Claims 20 and 26 have been canceled. Reconsideration and withdrawal of the Examiner's rejection of claims 20 and 26 are respectfully requested.

The Examiner has rejected claim 22 as being unpatentable over Alexander in view of Picco and further in view of Doherty. As discussed above with respect to the Examiner's obviousness rejection of claims 20 and 26, the combination of Alexander and Picco does not teach or suggest all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Doherty does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are

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believed to be allowable over the combination of Alexander, Pico and Doherty. Claim 22 has been canceled. Reconsideration and withdrawal of the Examiner's rejection of claim 22 are respectfully requested.

The Examiner has rejected claim 27 as being unpatentable over Alexander in view of Picco and further in view of Hendricks. As discussed above with respect to the Examiner's obviousness rejection of claims 20 and 26, the combination of Alexander and Picco does not teach or suggest all of the elements recited in independent claims 28 and 31. Applicant respectfully submits that Hendricks does not teach or suggest any of the elements missing from this combination. Thus, independent claims 28 and 31 are believed to be allowable over the combination of Alexander, Pico and Hendricks. Claim 27 has been canceled. Reconsideration and withdrawal of the Examiner's rejection of claim 27 are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 2-5, 10-12 and 28-40, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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